



STATUS AND ENTITY
BRANCH

2004 MAR 17 PM 4:39

DEP & REF
Room: 307

#12 000 400 000
PATENT
4/19/07

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: HIROSHI ITO, et al.

Serial No.: 10/009,070

Group No.: 1755

Filed: December 7, 2001

Examiner.: --

For: INK COMPOSITION

Attorney Docket No.: U 013769-3

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sirs:

REQUEST FOR REFUND

Deposit Account 12-0425 was charged \$180.00 for submission of Information Disclosure Statement (Fee Code 1806) on September 17, 2003 (Ref Txt No. 10009070).

However, the Information Disclosure Statement was mailed to the Patent Office on September 12, 2003 well within the three month mailing date of June 26, 2003 of the European Search Report and it was accompanied by the Statement. Attached are copies of the European Search Report and the Statement.

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450.

JANET L. CORD

(Type or print name of person mailing paper)

Date: March 10, 2004

(Type or print name of person mailing paper)

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Refund of the \$180.00, by credit, to Deposit Account 12-0425 is requested 28 MAR 17 PM 4:39

Respectfully submitted,

*Clifford J. Mass by
Cord Regda*
CLIFFORD J. MASS
LADAS & PARRY
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NEW YORK, NEW YORK 10023
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33,778



Applicant's Docket No. U013766-3

STATUS AND ENTRY
PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

2003 MAR 17 PM 4:39

In re application of: **HIROSHI ITO, ET AL.**
Application No.: 10/009,070
Filed: DECEMBER 7, 2001
For: INK COMPOSITION

Group No.: 1755
Examiner:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

STATEMENT FOR INFORMATION DISCLOSURE UNDER 37 C.F.R. SECTION 1.97(e)

NOTE: A statement must state either: "(1) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement." 37 C.F.R. Section 1.97(e).

Under the first statement under § 1.97(e), it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report. The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. See § 609B(5), M.P. E. P., 8th Edition.

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10^a

(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

- ☒ deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. 1.8(a)

- ☒ with sufficient postage as first class mail.

37 C.F.R. 1.10^a

as "Express Mail Post Office to Addressee"
Mailing Label No. _____ (mandatory)

TRANSMISSION

- ☐ transmitted by facsimile to the Patent and Trademark Office.

Date: September 12, 2003

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

* Only the date filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

NOTE: "Section 1.97(e) makes it clear that each item of information in an information disclosure statement is based on two statements. One statement is that each item of information in an information disclosure statement is based on a search report from a patent office outside the U.S. not more than three months prior to the filing date of the statement. Under this certification, it would not matter whether any individual with knowledge of any of the information cited before receiving the search report. In the alternative, the certification could state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person filing the statement after making reasonable inquiry, was known to any individual having a duty to disclose more than three months prior to the filing of the statement." Notice of January 9, 1992, 1135 O.G. 13-25, at 13 (emphasis added). Thus, "If an item of information is submitted within three months of being cited in a communication from a foreign patent office to a counterpart foreign application, the certification can be properly made regardless of any individual's previous knowledge of the information." *Id.*, 1135 O.G. at 19. See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. If the communication contains two dates, the mailing date of the communication is the one which begins the 3-month period. The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner. Likewise, the statement will be considered to have been filed on the date the statement was received in the Office, or on an earlier date of mailing or transmission if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 C.F.R. 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 C.F.R. 1.10." See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "The certification can be based on a person's good faith knowledge about when information became known without a search of files being made." Thus, for example, the certification of § 1.97(e) does not preclude the use of the certification in an application by corporations whose practitioners have over the years reviewed thousands of patents and technical publications even though they are unaware of the relevance of any one thereof to the application. Notice of January 9, 1992, 1135 O.G. 13-15, at 19.

See § 609B(5), M.P.E.P., 8th Edition.

"If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the information is being submitted within 3 months of the date on the communication, the copy will be considered as required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person filing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement."

NOTE: A copy of the foreign search report need not be submitted with the certification. Notice of April 20, 1992 (1138 O.G. 37-41, 48).

NOTE: "The phrase 'after making reasonable inquiry' makes it clear that the individual making the certification has a duty to make reasonable inquiry regarding the facts that are being certified. The certification can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client about being informed whether the information was known for more than three months, however, cannot rely on the information without making reasonable inquiry. For example, if an inventor gave a practitioner information about the information and should have known that the inventor became aware of the publication and should not submit a certification under 37 C.F.R. 1.97(e)(2) to the Office until a satisfactory response is received. The certification can be based on a person's good faith knowledge about when information became known without a search of files." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "Although it is not required that an individual actually becomes aware of the information in the communication, the mailing date of such a communication, if it is mailed, would determine the date for filing of an information disclosure statement without a fee" in a certification procedure under Section 1.97(e). Notice of January 9, 1992, 1135 O.G. 13-25, at 19 (emphasis added).

NOTE: The mere absence of evidence of information for a foreign patent office communication is not intended to represent an opportunity for the submission of a statement more than three months prior to the filing of an information disclosure statement to an individual having the duty of disclosure under Section 1.56.

NOTE: "The certification under Section 1997(e) should be made by a person who has knowledge of the facts being certified. The certification should be made by a practitioner who represents a foreign client and who relies on statements made by the foreign client as to the data the information first became known. A practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry." Notice of January 9, 1992, 1135 O.G. 13-25 at 19.

O.G. 37-41, 39).

NOTE: "Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent or inventor." 37 C.F.R. Section 1.56(d) and

section are:

- (1) each inventor named in the application;
- (2) each attorney or agent who prepares or prosecutes the application; and
- (3) every other person who is substantially involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application. 37 C.F.R. Section 1.56(c).

1. This statement is being made for the Information Disclosure Statement
☒ accompanying this statement.
☐ filed _____ Date _____

Date _____

STATEMENT

that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(1).

OR

that no item of information disclosed in the information disclosure statement was cited in a communication from [redacted] to the [redacted] application and to the knowledge of the person signing the statement after making reasonable inquiry, was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(2).

NOTE: "The time at which information was known to any individual designated in 37 C.F.R. 1.56(c) is the time when the information was discovered in association with the application even if awareness of the materiality came later." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

IDENTIFICATION OF PERSON(S) MAKING THIS STATEMENT

3. The person making this statement is

(check each applicable item)

(a) ☐ the inventor(s) who signs below

SIGNATURE OF INVENTOR

(type name of inventor who is signing)

(b) ☐ a person who is substantively involved in the preparation or prosecution of the application, and who is associated with the inventor, with the assignee, or with anyone to whom there is an obligation to assign the application (37 C.F.R. Section 1.56(c)) and who signs below.

SIGNATURE OF PERSON MAKING STATEMENT

(type name of person who is signing)

Address of person who is signing

(c) ☒ the practitioner who signs below on the basis of the information:

(check each applicable item)

- ☐ supplied by the inventor(s).
☒ supplied by an individual designated in Section 1.56(c).
☒ in the practitioner's file.

SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS

(type or print name of practitioner)

Reg. No. 30,086

Tel. No. (212) 708-1890

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STATUS AND ENTITY
BRANCH

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2nd Division
In Den Haag
Recherche non-
nominale

1st Division
La Haye
Recherche nominale

Département à
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Division de la
recherche

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Stockmair & Schwanhäusser
Anwaltssozietät
Maximilianstrasse 58
80538 München
ALLEMAGNE

GRÜNECKER, KINKELDEY, STOCKMAIR
& SCHWANHÄUSSER
ANWALTSSOZIELTÄT

27. Juni 2003

FIRST
TERM

EINGANG - RECEIVED

Datum/Date

26.06.03

Zeichen/Ref./Réf.

EP 23114-009

Anmeldung Nr./App. No./Demande n°/Patent Nr./Patent No./Brevet n°
61921813.0

Anmelder/Applicant/Demandeur/Patentinhaber/Propriétaire/Titulaire
Seiko Epson Corporation

COMMUNICATION

The European Patent Office herewith transmits

- ☐ the European search report
- ☐ the declaration under Rule 45 EPC
- ☐ the partial European search report under Rule 48 EPC
- ☒ the supplementary European search report concerning the international application under Article 157(2) EPC relating to the above-mentioned European patent application. Copies of the documents cited in the search report are enclosed.

The following specifications given by the applicant have been approved by the Search Division :

☐ Abstract

☐ Title

☐ Figure

☐ The abstract was modified by the Search Division and the definitive text is attached to this communication.

☐ The following figure will be published with the abstract, since the Search Division considers that it better characterises the invention than the one indicated by the applicant.

Figure:

☐ Additional copy(ies) of the document cited in the European search report.

REFUND OF THE SEARCH FEE

If applicable under Article 10 Rules relating to fees, a copy of this communication from the Receiving Section on the refund of the search fee will be sent later.

EPO Form 1507 02.93

STATUS AND ENTRY
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European Patent
Office

Application Number

EP 01 92 1813

CLAIMS INCURRING FEES

The present European patent application comprises at the time of filing more than ten claims.

☐ Only part of the claims have been drawn up within the prescribed time limit. The present European search report has been drawn up for the first ten claims and for those claims for which claims fees have been paid, namely claim(s):

☐ No claims fees have been paid within the prescribed time limit. The present European search report has been drawn up for the first ten claims.

LACK OF UNITY OF INVENTION

The Search Division considers that the present application does not comply with the requirements of unity of invention and contains two or more inventions, namely:

see sheet B

☒ All further search fees have been paid within the fixed time limit. The present European search report has been drawn up for all claims.

☐ As all searchable claims have been drawn up without effort justifying an additional fee, the Search Division did not invite payment of any additional fee.

☐ Only part of the further search fees have been paid within the fixed time limit. The present European search report has been drawn up for the first ten claims of the European patent application which relate to the inventions in respect of which search fees have been paid, namely claims:

☐ None of the further search fees have been paid within the fixed time limit. The present European search report has been drawn up for the first ten claims of the European patent application which relate to the invention first mentioned in the claim(s) of the said application.

STATUS AND ENTITY
BRANCH



European Patent
Office

LACK OF UNITY OF INVENTION
SHEET B

Application Number
EP 01 92 1813

The Search Division considers that the present European patent application does not comply with the requirements of unity of invention and relates to several inventions or groups of inventions, namely:

1. Claims: 1-12

Ink composition comprising a colorant, a humectant, a glycol monoether, an 1,2-alkanediol and water.

2. Claims: 13-32

Ink composition comprising a pigment, a dispersant for the pigment, an 1,2-alkanediol and water.

STATUS AND ENTITY
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ANNEX TO THE EUROPEAN SEARCH REPORT ON EUROPEAN PATENT APPLICATION NO.

EP 01 92 1813

This annex lists the patent family members of the patent document cited in the above-mentioned European search report.
The members are as contained in the European Patent Office's database.
The European Patent Office is in no way liable for the accuracy of the information given for the purpose of information.

16-06-2003

Patent document cited in search report	Publication date	Patent family member(s)	Publication date
EP 0879858 A	25-11-1998	US 6538049 B1	25-03-2003
		CN 1201057 A	09-12-1998
		EP 0879858 A2	25-11-1998
		TM 464677 B	21-11-2001
JP 11349871 A	21-12-1999	NONE	
EP 0761783 A	12-03-1997	DE 69616914 D1	20-12-2001
		DE 69616914 T2	04-04-2002
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		JP 10095941 A	14-04-1998
		US 6004389 A	21-12-1999
		US 5746818 A	05-05-1998
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		DE 69616914 T2	04-04-2002
		EP 0761783 A2	12-03-1997
		US 6004389 A	21-12-1999
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		DE 69616914 T2	04-04-2002
		EP 0761783 A2	12-03-1997
		JP 10095941 A	14-04-1998
		US 5746818 A	05-05-1998
US 5707433 A	13-01-1998	NONE	

EP FORM P

For more details about this annex : see Official Journal of the European Patent Office, No. 12/82

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